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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte SAMUEL N. ZELLNER, MARK J. ENZMANN,
and
ROBERT T. MOTON, JR.

Appeal 2008-005864
Application 09/740,375
Technology Center 3600

Decided: February 5, 2010

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R. MOHANTY, Administrative Patent Judges.

FETTING, Administrative Patent Judge.

DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 Samuel N. Zellner, Mark J. Enzmann, and Robert T. Moton, Jr.
3 (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of
4 claims 21-30, the only claims pending in the application on appeal.

5 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
6 (2002).

7 We AFFIRM.

8 The Appellants invented a method of providing an identity-blocking
9 service, obtaining an identity of a user operating a wireless communication
10 device; obtaining information about a location of the user; and transferring
11 the information about the location of the user to a third party without
12 disclosing the identity of the user to the third party or transferring the
13 identity information for the user to a third party without disclosing the
14 location information for the user to the third party. (Spec. 5:3-6:7).

15 An understanding of the invention can be derived from a reading of
16 exemplary claim 21, which is reproduced below [bracketed matter and some
17 paragraphing added].

18 21. A method of sending an advertisement to a user operating a
19 wireless communication device, comprising:
20 [1] sending first information about a location of the user
21 to a content provider
22 that provides web content to the wireless communication
23 device;
24 [2] sending an indication to the content provider
25 when the location is continuously changing;
26 [3] searching a first database
27 containing a plurality of location-specific advertisements;
28 [4] selecting a first one of the plurality of location-specific
29 advertisements
30 that is associated with the location of the user and

1 is desired to be sent to the user at a stable location that is
2 not continuously changing; and
3 [5] sending the first one of the plurality of location-specific
4 advertisements
5 to the wireless communication device
6 over a communication network
7 when the location is stable and not continuously
8 changing.

9
10 This appeal arises from the Examiner's Final Rejection, mailed May
11 19, 2006. The Appellants filed an Appeal Brief in support of the appeal on
12 April 19, 2007. An Examiner's Answer to the Appeal Brief was mailed on
13 June 19, 2007. A Reply Brief was filed on August 20, 2007.

14

PRIOR ART

15 The Examiner relies upon the following prior art:

16 Goldhaber US 5,794,210 Aug. 11, 1998
17 Hendrey US 2002/0102993 A1 Aug. 1, 2002

18

REJECTIONS

20 Claims 21 and 26 stand rejected under 35 U.S.C. § 103(a) as
21 unpatentable over Hendrey.

23 Claims 22-25 and 27-30 stand rejected under 35 U.S.C. § 103(a) as
24 unpatentable over Hendrey and Goldhaber.

25

ISSUES

27 The issue of whether the Appellants have sustained their burden of
28 showing that the Examiner erred in rejecting claims 21 and 26 under 35
29 U.S.C. § 103(a) as unpatentable over Hendrey turns primarily on the

1 predictability of sending an advertisement to a prospect in Hendrey after the
2 prospect entered a store.

3 The issue of whether the Appellants have sustained their burden of
4 showing that the Examiner erred in rejecting claims 22-25 and 27-30 under
5 35 U.S.C. § 103(a) as unpatentable over Hendrey and Goldhaber turns
6 primarily on the patentability of claim 21.

7

8 FACTS PERTINENT TO THE ISSUES

9 The following enumerated Findings of Fact (FF) are believed to be
10 supported by a preponderance of the evidence.

11 *Hendrey*

12 01. Hendrey is directed to mobile telecommunications systems that
13 have the ability to deliver advertisements to mobile units and
14 determine a geographically precise location of mobile units in the
15 mobile telecommunications system (Hendrey ¶ 0002).

16 02. Once a prospect has been identified, Hendrey creates a tailored
17 advertising message responsive to the prospect's location using a
18 location-sensitive advertising content generation subsystem, and
19 sends it the prospect. At this point the prospect is considered
20 "active" in that the advertisement has been delivered and that the
21 prospect can respond to that advertisement (Hendrey ¶ 0038).

22 03. While a prospect is considered active, Hendrey continually
23 monitors the location of the prospect and checks whether a
24 prospect has entered a store relevant to the advertising content. If
25 a prospect has in fact entered the store relevant to the advertising
26 content, the advertisement is considered a success and the

1 prospect status is changed to be considered inactive. In one
2 embodiment the well-known concept of hysteresis in either time
3 or location would be used to prevent the generation of another
4 advertising message to a customer who has just responded to an
5 advertisement and has not yet left the area used to trigger
6 advertising. If the prospect has not entered the store, Hendrey
7 continues to monitor the prospect's location to determine whether
8 the prospect is likely to respond to the advertisement. If a
9 prospect has moved far from the desired store location, the
10 advertisement is considered to have failed. If too much time has
11 elapsed from the generation of the advertising content the prospect
12 might be considered inactive. If it is determined that the prospect
13 is unlikely to respond to the advertising content sent, the prospect
14 is marked as inactive (Hendrey ¶ 0039-42).

15 04. Hendrey describes monitoring the general location of a
16 customer over a period of time to see if traveling of the prospect
17 ceased in the general vicinity of the store to determine whether the
18 prospect visited the store or merely stopped nearby it. This
19 provides suggestive evidence that the advertisement caused the
20 user to stop and shop at the store. Hendrey also describes
21 monitoring the travel direction to see if a customer reacts to an
22 advertisement. For example, an advertisement may be triggered
23 when a prospect is within a predetermined radius of the business,
24 such as 500 meters, then determining whether the prospect has
25 moved toward the sponsoring business' store, for example entering
26 within a 100 meter radius of the store. To refine this scenario

1 further, cessation of movement could be detected within such a
2 minimum radius for a duration of time consistent with either
3 making the desired transaction or investigating the advertised
4 product (Hendrey ¶ 0047-48).

5 *Goldhaber*

6 05. Goldhaber is directed to delivering information electronically
7 using techniques for delivering positively and negatively priced
8 intellectual property (including advertising) and attention
9 brokering, orthogonal sponsorship, and/or privacy protection in an
10 electronic information delivery network (Goldhaber 1:4-11).

11 *Facts Related To The Level Of Skill In The Art*

12 06. Neither the Examiner nor the Appellants has addressed the level
13 of ordinary skill in the pertinent arts of systems analysis and
14 programming, advertising, and promotion design. We will
15 therefore consider the cited prior art as representative of the level
16 of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d
17 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings
18 on the level of skill in the art does not give rise to reversible error
19 ‘where the prior art itself reflects an appropriate level and a need
20 for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v.*
21 *Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

22 *Facts Related To Secondary Considerations*

23 07. There is no evidence on record of secondary considerations of
24 non-obviousness for our consideration.

1 PRINCIPLES OF LAW

2 *Claim Construction*

3 During examination of a patent application, pending claims are
4 given their broadest reasonable construction consistent with the
5 specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In*
6 *re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

7 Limitations appearing in the specification but not recited in the claim
8 are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d
9 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the
10 specification” without importing limitations from the specification into the
11 claims unnecessarily).

12 Although a patent applicant is entitled to be his or her own
13 lexicographer of patent claim terms, in *ex parte* prosecution it must be
14 within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant
15 must do so by placing such definitions in the specification with sufficient
16 clarity to provide a person of ordinary skill in the art with clear and precise
17 notice of the meaning that is to be construed. *See also In re Paulsen*, 30
18 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the
19 specific terms used to describe the invention, this must be done with
20 reasonable clarity, deliberateness, and precision; where an inventor chooses
21 to give terms uncommon meanings, the inventor must set out any
22 uncommon definition in some manner within the patent disclosure so as to
23 give one of ordinary skill in the art notice of the change).

24 *Obviousness*

25 A claimed invention is unpatentable if the differences between it and
26 the prior art are “such that the subject matter as a whole would have been

1 obvious at the time the invention was made to a person having ordinary skill
2 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 550
3 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

4 In *Graham*, the Court held that the obviousness analysis is bottomed
5 on several basic factual inquiries: “[1] the scope and content of the prior art
6 are to be determined; [(2)] differences between the prior art and the claims at
7 issue are to be ascertained; and [(3)] the level of ordinary skill in the
8 pertinent art resolved.” 383 U.S. at 17. *See also KSR*, 550 U.S. at 406.
9 “The combination of familiar elements according to known methods is likely
10 to be obvious when it does no more than yield predictable results.” *Id.* at
11 416.

12 “When a work is available in one field of endeavor, design incentives
13 and other market forces can prompt variations of it, either in the same field
14 or a different one. If a person of ordinary skill can implement a predictable
15 variation, § 103 likely bars its patentability.” *Id.* at 417.

16 “For the same reason, if a technique has been used to improve one
17 device, and a person of ordinary skill in the art would recognize that it would
18 improve similar devices in the same way, using the technique is obvious
19 unless its actual application is beyond his or her skill.” *Id.*

20 “Under the correct analysis, any need or problem known in the field
21 of endeavor at the time of invention and addressed by the patent can provide
22 a reason for combining the elements in the manner claimed.” *Id.* at 420.

1 ANALYSIS

2 *Claims 21 and 26 rejected under 35 U.S.C. § 103(a) as unpatentable over*
3 *Hendrey.*

4 The Appellants argue these claims as a group. Accordingly, we select
5 claim 21 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

6 The Examiner found that Hendrey described the limitations of claim
7 21 except for sending an advertisement when it is determined the prospect
8 has stopped. The Examiner found that one of ordinary skill would have
9 found it desirable to send an advertisement when a prospect is in a store and
10 concluded that it would have been obvious to a person of ordinary skill in
11 the art to have sent such an advertisement with Hendrey's system (Ans. 3-4).

12 The Appellants contend that Hendrey does not suggest or teach
13 tracking a location of a user, determining whether the location is constantly
14 changing, and sending advertisements which are desired to be sent when the
15 location is determined to be stabled and not constantly changing (App. Br.
16 8:Top ¶) or selecting a first location-specific advertisement associated with
17 the location of the user and sending it to the wireless device when the
18 location is stable and not continuously changing (App. Br. 8:Bottom ¶ - 9),
19 and that the requisite motivation for modifying the Hendrey reference is
20 lacking (App. Br. 9:Last full ¶).

21 We disagree with the Appellants. Hendrey describes tracking a
22 location of a user and determining whether the location is constantly
23 changing (FF 04). Hendrey also describes sending advertisements which are
24 desired to be sent when the prospect is active (FF 02) and continually
25 monitoring the location of the prospect and checking whether a prospect has
26 entered a store relevant to the advertising content (FF 03). Thus the only
27 issue is whether it was predictable to one of ordinary skill to send another

1 advertisement after the location stopped changing because the prospect
2 entered a store. While we agree with the Appellants that Hendrey does not
3 explicitly describe doing so, one of ordinary skill, and indeed most
4 consumers of much lesser skill, had experience with stores providing
5 advertising within their premises prior to the filing date. With such
6 knowledge, one of ordinary skill would have been motivated to provide the
7 electronic equivalent of such in store advertising for promotions beyond that
8 in the advertisement that led the prospect into Hendrey's store. “[A] court
9 must ask whether the improvement is more than the predictable use of prior
10 art elements according to their established functions. *KSR*, 550 U.S. at 417.
11 “[T]he analysis need not seek out precise teachings directed to the specific
12 subject matter of the challenged claim, for a court can take account of the
13 inferences and creative steps that a person of ordinary skill in the art would
14 employ.” *Id.* 550 U.S. at 418. “In many fields it may be that there is little
15 discussion of obvious techniques or combinations, and it often may be the
16 case that market demand, rather than scientific literature, will drive design
17 trends.” *Id.* 550 U.S. at 419. We find that market demand for promotional
18 advertising oriented towards prospects already within a vendor's premises is
19 so notoriously well known as to be such a technique.

20
21 *Claims 22-25 and 27-30 rejected under 35 U.S.C. § 103(a) as unpatentable*
22 *over Hendrey and Goldhaber.*

23 The Appellants rely primarily on the arguments in support of claim
24 21. The Appellants also argue that the features of claims 22-25 and 27-30
25 have not been taught or suggested by the cited art in the manner claimed
26 (App. Br. 13). “A statement which merely points out what a claim recites
27 will not be considered an argument for separate patentability of the claim.”

1 37 C.F.R. § 41.37(c)(1)(vii) (2007). By the same token, a statement which
2 merely alleges that a claim recites patentable features without even
3 identifying those features will not be considered an argument for separate
4 patentability. Accordingly these claims fall with claim 21.

5

CONCLUSIONS OF LAW

7 The Appellants have not sustained their burden of showing that the
8 Examiner erred in rejecting claims 21 and 26 under 35 U.S.C. § 103(a) as
9 unpatentable over Hendrey.

10 The Appellants have not sustained their burden of showing that the
11 Examiner erred in rejecting claims 22-25 and 27-30 under 35 U.S.C. §
12 103(a) as unpatentable over Hendrey and Goldhaber.

13

DECISION

15 To summarize, our decision is as follows:

- The rejection of claims 21 and 26 under 35 U.S.C. § 103(a) as unpatentable over Hendrey is sustained.
 - The rejection of claims 22-25 and 27-30 under 35 U.S.C. § 103(a) as unpatentable over Hendrey and Goldhaber is sustained.

20 No time period for taking any subsequent action in connection with
21 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

22

AFFIRMED

24

Appeal 2008-005864
Application 09/740,375

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